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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/176,580 | 10/21/1998 | RAMESH SUNDARAM | S01.12-0460 | 2038 |

7590 05/28/2003
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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/176,580

Applicant(s)
Sundaram et al.

Examiner
Gail Verbitsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4-7, 9-14, 16, 18, 20, 21, and 23-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4-7, 9-14, 16, 18, 20, 21, and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Specification

1. A) The disclosure is finally objected to because of the following informalities: a brief description of Fig. 10 should be added in page 5 of the specification.

B) Specification is objected because, it is not clear from the specification if the method steps claimed in claims 18, 21 and 26 refer to conventional (previous) practices or to the preferred embodiment. Appropriate correction/ clarification is required. No new matter should be entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18, 21 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, it is not clear whether the method steps (depositing the transducers on the glide bodies sliced from the wafer), as stated in claims 18, 21, and (depositing the transducers prior to slicing), as stated in claim 26, described in the specification refer to conventional (previous) practices or to the preferred embodiment.

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Claim 20 is rejected by virtue of its dependency on claim 18.

4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it is not clear from the claims how the glide test system is structurally related to the glide body.

Claims 4-7, 9-14, 16, 23 are rejected by virtue of their dependency on claim 2.

Claim Objections

5. Claims 2, 4-7, 9-14, 23 are finally objected to because of the following informalities: the preamble of the claims dependent on claim 2 should be replaced with --"The glide test system-- . Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 2, 4-6, 10-11, 14, 16, 23, 25- 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Boutaghou.

Boutaghou discloses in Figs. 1-4 and 13 a glide test system having a thermal asperity sensor comprising a slider body 12 having a leading edge A, transducers (plurality of magnetoresistive sensors/ MR) 18 spaced apart along the length of rails (elevated/ raised bearing

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surface) 26 of an air bearing surface 14 ABS (col. 6, lines 6-7 and Fig. 1). Each transducer has layers, thus, constituting a thin (having thickness/ height) flat (col. 7, line 20) asperity contacting surface (length) oriented along the ABS. As shown in Fig. 1, the transducers are oriented along (portion extending) the ABS. Inherently, the thickness of the transducer is intersecting (contacting) with its portion extending along the ABS.

For claim 10: the transducers extend substantially from the leading edge to the trailing edge, as shown in Fig. 4.

For claim 14: Boutaghou states that the transducer can be a PZT (col. 2, line 14),

For claim 26: Boutaghou states that the transducers are fabricated at the wafer level (col. 3, line 22), i.e., prior to slicing. (The numerals A- B have been added by the Examiner, see attachment to the previous Office Action).

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Response to Arguments

14. Applicant's arguments filed on March 11, 2003 have been fully considered but they are not persuasive.

Applicant states that 102(e) rejection using Bougtahou is not applicable in this case since Applicant filed a CPA on September 05, 2001, and thus the application should not be examined under 35 U.S.C. 102(e) after amendment of the AIPA. In this case, the applicant is correct with respect to 103 rejection, since the amendment of the AIPA in this case applied only to 103 rejection, however, this argument is not persuasive with respect to 102(e) rejection. Therefore, 103 rejection is hereby withdrawn.

Allowable Subject Matter

15. A) Claims 7, 9, 12-13, 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

C) Claims 18-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 disclose related devices.

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17. Any inquiry concerning this communication should be directed to the examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry related to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

GKV

May 15, 2003

Gail Verbitsky

A handwritten signature in cursive script, appearing to read 'G. Verbitsky', with a long horizontal flourish extending to the right.

Patent Examiner, TC 2800